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EXAMINER

ROBINSON BOYCE, AKIBA K

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* SABUROU IKEDA  
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10  
11 Appeal 2007-4043  
12 Application 09/893,706  
13 Technology Center 3600  
14

15  
16 Decided: June 30, 2008  
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18  
19 *Before* WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and  
20 HUBERT C. LORIN, *Administrative Patent Judges*.

21  
22 CRAWFORD, *Administrative Patent Judge*.  
23

24  
25 DECISION ON APPEAL  
26

27 STATEMENT OF CASE

28 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection  
29 of claims 1 to 20 and 23. Claims 21 and 22 have been canceled. We have  
30 jurisdiction under 35 U.S.C. § 6(b) (2002).

31 Appellant invented an electronic toll payment system for a highway  
32 toll and a transportation management system (Specification 1).

1 Claim 1 under appeal reads as follows:

2 1. A toll payment system which comprises:  
3 a portable telephone on a car of a contractor of electronic toll  
4 payment service;  
5 base stations connected with said portable telephone;  
6 and  
7 a server connected with said base stations,  
8 wherein said server comprises:  
9 a first memory for storing locations of said base stations;  
10 a second memory for storing names of contractors or their car  
11 numbers and unit toll for each section along a highway;  
12 a driving route identification unit for identifying a driving route of  
13 said portable telephone on the basis of said locations of said base  
14 station which are connected with said portable telephone;  
15 a toll calculation unit for calculating a toll on the basis of said  
16 unit toll and the identified driving route; and  
17 a toll charging unit for charging said portable telephone the  
18 calculated toll.

19  
20 The Examiner rejected claims 1 to 20 and 23 under 35 U.S.C.

21 § 103(a) as being unpatentable over Treyz in view of Hassett.

22 The prior art relied upon by the Examiner in rejecting the claims on  
23 appeal is:

|    |         |                 |               |
|----|---------|-----------------|---------------|
| 24 | Hassett | US 6,653,946 B1 | Nov. 25, 2003 |
| 25 | Treyz   | US 6,711,474 B1 | Mar. 23, 2004 |

26  
27 Appellant contends that Treyz does not disclose a second memory for  
28 storing names of contractors or their car numbers.

29 Appellant also contends that Hassett does not disclose a toll  
30 calculation unit for calculating a toll on the basis of the unit toll that serves  
31 plural vehicles.

32

ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in finding that Treyz discloses a second memory for storing names of contractors or their car numbers.

The second issue is whether the Appellant has shown that the Examiner in finding that Hassett discloses a toll calculation unit for calculating a toll on the basis of the unit toll that serves plural vehicles.

FINDINGS OF FACT

Treyz discloses a toll payment system which comprises a portable telephone, which is part of a personal computer 14, in a car of a person who has contracted for toll services (col. 45, ll. 50 to 54; col. 54, ll. 46 to 52). Base stations 56 are connected with the personal computer 14 (col. 11, ll. 3 to 10). A server on the contractor's personal computer 14 is connected with the base stations via a wireless connection (col. 17, l. 66 to col. 18, l. 3; Figure 2). The server includes a first memory for storing locations of the base stations (col. 11, ll. 51 to 56; col. 44, ll. 15 to 22). The server also includes a second memory on a digital camera 170 (Figure 3). Treyz discloses that the digital camera 170 is capable of capturing license plate images and may be placed in any suitable location (col. 78, ll. 8 to 32). Treyz discloses that tolls may be collected using the server (col. 54, ll. 31 to 52). A toll calculation unit at a toll collection facility for calculating the toll and the identified driving route is implicit and certainly suggested by the Treyz disclosure because the toll must be calculated before it is collected.

Hassett discloses a toll calculation unit for calculating a toll on the basis of a unit toll and the identified route (col. 4, ll. 31 to 33).

ANALYSIS

We are not persuaded of error on the part of the Examiner by the Appellants argument that Treyz does not disclose a second memory for storing names of contractors or their car numbers. Specifically, Appellants argue that the digital computer disclosed in Treyz captures images of the license plate of a car that may be tailgating the driver and thus the digital computer does not store images of *contractors* or the car numbers or names of the *contractors*.

We agree with the Examiner that the driver of the vehicle is a contractor as broadly claimed because this person has entered into a contract with the electronic payment service and that the license plate number of the driver is a car number. In addition, we agree with the Examiner that the memory of the digital camera is capable of storing the license plate number of the drivers or contractors because the camera as disclosed can be placed in any location which would include a location in which the driver's license plate number can be captured.

We note that the phrase in claim 1 of "for storing names of contractors or their car numbers" is a statement of intended use. The manner or method in which a machine is to be utilized is not germane to the issue of patentability of the machine itself. *In re Casey*, 370 F.2d 576, 580 (CCPA 1967). A statement of intended use does not qualify or distinguish the structural apparatus claimed over the reference. *In re Sinex*, 309 F.2d 488, 492 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. *See generally Kropa v. Robie*,

1 187 F.2d 150, 155-59 (CCPA 1951) and the authority cited therein, and  
2 cases compiled in 2 *Chisum, Patents* § 8.06[1][d] (1991). Therefore, as the  
3 digital camera of Treyz is capable of storing the car license numbers of the  
4 driver, Treyz meets this limitation of claim 1.

5 We are also not persuaded by Appellant's argument that Hassett does  
6 not disclose a toll calculation unit for calculating a toll on the basis of the  
7 unit toll that serves plural vehicles. Firstly, as Treyz discloses that a toll  
8 charge can be collected through the system, a toll calculation unit is implicit  
9 and certainly suggested by the Treyz disclosure alone. In addition, Treyz is  
10 being relied on for teaching a toll payment system that serves plural  
11 vehicles. Hassett is relied on for specifically teaching a toll calculation unit  
12 for calculating a toll on the basis of unit toll and identified driving route.

13 We are likewise not persuaded of error on the part of the Examiner by  
14 Appellant's arguments that Hassett does not disclose collection of tolls using  
15 a portable telephone or that Treyz does not disclose how the tolls are  
16 calculated, because the rejection is based on the combined teachings of  
17 Hassett and Treyz. In this regard, Treyz teaches collecting tolls using a  
18 portable telephone, and Hassett discloses that the tolls are collected based on  
19 the unit toll and identified driving route.

1 In view of the foregoing, we will sustain the Examiner's rejection as it  
2 is directed to claim 1. We will also sustain the Examiner's rejection as it is  
3 directed to claims 2 to 20 and 23 because the Appellant has not argued the  
4 separate patentability of these claims.

5 The decision of the Examiner is affirmed.

6 No time period for taking any subsequent action in connection with  
7 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

8  
9 AFFIRMED

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